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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,785	03/13/2001	Russell E. Evans	259/225	2980

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EXAMINER

FINEMAN, LEE A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/804,785

Applicant(s)

EVANS ET AL.

Examiner

Lee Fineman

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AW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 32-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 13.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 November 2003 has been entered in which claim 1 was amended and claim 31 was cancelled. Claims 1-12 and 32-38 are pending.

### *Claim Objections*

2. Claim 32 is objected to because of the following informalities: Claim 32 has the limitations "a first side and an opposing second side." However since amended claim one already states the first and second sides, the limitation of claim 32 should be changed to --the first side and the opposing second side-- or removed as redundant from the dependent claim. Appropriate correction is required.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 8 of U.S. Patent No. 6,413,641 and claims 1 and 3 of U.S. Patent No. 6,585,373. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are an obvious variation of the claims of U.S. Patent No. 6,413,641 or U.S. Patent No. 6,585,373. The polarizer in each of the patents must have a side, which can be called the "first side," that is optically bonded to a bonding surface of optical construct.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-5, 11-12 and 32-38 rejected under 35 U.S.C. 102(e) as being Smith by U.S. Patent No. 6,096,425.

Regarding claims 1, 3-4, 32 and 38, Smith discloses an optical-quality polarized part (fig. 1) comprising an optical construct (1, 2, 4 and 5) having a bonding surface (fig. 1) and comprising a high impact polyurethane-based optical material (2 and 4, column 3, lines 22-23 and 34-36); a polarizer (3), which is a wafer (fig. 1) comprising cellulose triacetate (column 3,

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lines 7-9), having a first side (next to 2) and an opposing side (next to 4) where in the first side and second side of the polarizer are integrally bonded to the optical construct across the entire bonding surface thereof, in a prescribed place thereon (fig. 1); and wherein the polarizer comprises at least one layer supporting a polyvinyl alcohol film (column 3, lines 7-9).

Regarding claim 5, Smith further discloses wherein the optical construct is a lens substrate (column 1, line 10 (sunglasses)).

Regarding claims 11 and 12, Smith further discloses comprising a hard coating (column 3, lines 16-18), wherein the hard coating is integrally bonded to the optical construct and therefore the polarizer within it.

Regarding claims 33 and 35, Smith further discloses wherein the polarizer is treated and bonded to the optical construct after the optical construct has been formed (column 4, lines 9-14).

Regarding claim 34, Smith further discloses wherein the optical construct has a front surface and an opposing rear surface (fig. 1) and wherein the polarizer is bonded to the optical construct near the front surface (fig. 1).

Regarding claims 36 and 37, Smith further discloses wherein the polarizer has a thickness of less than 0.2 mm (column 3, lines 47-48).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Kausch et al., U.S. Patent No. 6,113,811.

Smith discloses the claimed invention except for the polarizer comprising a polyethylene terephthalate film. Kausch et al. teaches a polarizer comprising a polyethylene terephthalate film (column 10, lines 52-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the polarizer of Kausch in the optical-quality polarized part of Smith to reduce glare (Kausch, column 1, line 13).

9. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Slagel, US Patent No. 6,127,505.

Smith discloses the claimed invention except for wherein the high impact polyurethane-based optical material is comprising a polyurethane prepolymer including a dye or colorant; wherein the prepolymer comprises up to about 12 molar percent of trimethylol propane; and wherein the high impact polyurethane-based optical material comprises a reaction product of (a) a polyurethane prepolymer prepared by reaction of a methylenebis (cyclohexyl isocyanate) with an OH-containing intermediate having a weight average molecular weight between about 500 and about 1,200 selected from the group consisting of polyester glycols, polyether glycols, and mixtures thereof in an equivalent ratio of 2.5 to 4.0 NCO/1.0 OH and (b) an aromatic diamine curing agent in an equivalent ratio of about .9 to 1.1 NH<sub>2</sub>/1.0 NCO. Slagel teaches an optically clear high impact polyurethane-based optical material (column 2, lines 4-10) comprising a

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polyurethane prepolymer including a dye or colorant (column 6, lines 7-10, table 1) wherein the prepolymer comprises up to about 12 molar percent of trimethylol propane (column 5, line 65-column 6 line 5), and wherein the high impact polyurethane-based optical material comprises a reaction product of (a) a polyurethane prepolymer prepared by reaction of a methylenebis (cyclohexyl isocyanate) with an OH-containing intermediate having a weight average molecular weight between about 500 and about 1,200 selected from the group consisting of polyester glycols, polyether glycols, and mixtures thereof in an equivalent ratio of 2.5 to 4.0 NCO/1.0 OH and (b) an aromatic diamine curing agent in an equivalent ratio of about .9 to 1.1  $\text{NH}_2$ /1.0 NCO (column 1, line 59-column 2, line 3 and column 3, lines 16-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the polyurethane of Slagel in the optical construct of Smith to provide a optical product with high heat distortion temperatures and reduced cost (column 2, lines 11-18, Slagel).

### *Response to Arguments*

10. Applicant's arguments with respect to claims 1-12 and 32-38 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAF

April 12, 2004

  
**MARK A. ROBINSON**  
**PRIMARY EXAMINER**